

REMARKS

The present communication responds to the Office Action mailed December 21, 2004.

Double Patenting Rejection

Claims 1-41 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,706,009. A terminal disclaimer is submitted herewith over the '009 patent.

Rejection Under 35 U.S.C. § 112

Claims 1-12, 25-33 and 39 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description. The Examiner asserted that the claim language "wherein the injection needle protrudes through and seals the intake opening of the perfusion catheter when the injection needle is in the forward position" is not described in the specification and contradicts what is intended in the original disclosure. To expedite prosecution of the application, the applicants have amended the phrase "intake opening" to "distal opening" throughout the claims. The applicants have further amended the referenced claim language to recite "wherein the injection needle protrudes through the distal opening of the perfusion catheter when the injection needle is in the forward position." Withdrawal of the rejection is thus respectfully requested.

Claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 has been amended to recite "the distal opening of the injection needle is adapted to be in fluid communication with the perfusate supply when the injection needle is in the retracted position," thus overcoming this rejection. Withdrawal of the rejection is thus respectfully requested.

Rejection Under 35 U.S.C. § 102

*U.S. Patent No. 4,014,333 to McIntyre*

Claims 1, 2, 9, 13 and 23 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent 4,014,333 to McIntyre. This rejection is traversed at least for the following reasons.

McIntyre teaches an instrument for effecting aspiration and irrigation during ophthalmic surgery. The instrument comprises two, telescopically disposed cannulae and a connector which couples the two cannuli and forms fluid-tight seals with each. Each cannula consists of a rigid, small-diameter tube and a Luer hub (or "mount") coaxial therewith. There is no teaching or suggestion in McIntyre that either cannula be a needle. As stated at lines 14-17 of page 3 of the present specification, "The injection needle not only fulfills the function of positioning the perfusion catheter, but also fulfills the further function of introducing the perfusate into the perfusion catheter." It is later explained that, in positioning the perfusion catheter, the needle is used for piercing the skin (see page 10, line 28 – page 11, line 2 of the present specification). Piercing skin is normal usage of a needle. Neither cannula of McIntyre is suitable for piercing skin. The applicants thus respectfully submit that neither cannula of McIntyre can be properly interpreted as a "needle" as recited by independent claims 1 and 13. Further, McIntyre does not teach a proximal opening in an injection needle wherein the proximal opening is adapted to be in fluid communication with the perfusate supply when the injection needle is in a rearward position.

Independent claim 1 requires a hollow injection needle, the injection needle having a proximal opening wherein, in a rearward position of the injection needle, the proximal opening of the needle is adapted to be in fluid communication with the perfusate supply. Independent claim 13 similarly requires a hollow injection needle, the injection needle having a proximal opening wherein the proximal opening of the injection needle is adapted to be in fluid communication with the perfusate supply when the injection needle is in the retracted. Each of claims 2, 9 and 23 depend either directly or indirectly from independent claims 1 or 13.

The applicants thus respectfully submit that each of claims 1, 2, 9, 13 and 23 are patentable over McIntyre. Reconsideration and allowance are thus respectfully requested.

*U.S. Patent No. 4,096,860 to McLaughlin*

Claims 13 and 23 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent 4,096,860 to McLaughlin. The rejection is traversed at least for the following reasons.

The Examiner states that “Claim 13 recites that the discharge opening of the injection needle resides within the perfusion catheter when the injection needle is in the retracted position.” The Examiner concedes “this functional language is contrary to the intended use of McLaughlin; however, the claim is an article claim and does not recite any features which structurally distinguish over McLaughlin.” The applicants respectfully submit that this language is not functional language but is, in fact, structural language. Specifically, this language recites the position of the discharge opening with respect to the perfusion catheter. Such positional language is clear structural language. As conceded by the Examiner, McLaughlin does not teach a discharge opening of an injection needle residing within a perfusion catheter when the injection needle is in the retracted position. McLaughlin thus does not teach the *structure* of the micro-perfusion device of claim 13.

The applicants thus submit that claim 13 and its dependent claim 23 are allowable over McLaughlin. Accordingly, reconsideration and allowance are respectfully submitted.

*Allowable Subject Matter*

The present application includes independent claims 1, 13, 25 and 34. The independent claims were rejected variously as follows. Each of the independent claims was rejected under the judicially created doctrine of obviousness-type double patenting. Claims 1 and 13 were rejected under 35 U.S.C. 102(b) as anticipated by either McIntyre or McLaughlin. Claims 1 and 25 were rejected under 35 U.S.C. 112, first paragraph. Claim 1 was rejected under 35 U.S.C. 112, second paragraph. Thus, claim 34 was rejected under the double-patenting rejection and

claim 25 was rejected under the double-patenting rejection and under 35 U.S.C. 112, first paragraph. Neither claim 25 nor claim 34 were otherwise rejected.

Similarly, dependent claims 3-8, 10-12, 14-22 and 24 were rejected under obviousness-type double patenting or under 35 U.S.C. 112, first or second paragraph but were not otherwise rejected.

As set forth above, the claims have been amended to overcome the rejection under the rejections under 35 U.S.C. 112, first paragraph and second paragraph. A terminal disclaimer has been herewith submitted to overcome the obviousness-type double patenting rejection. The applicants thus respectfully submit that independent claims 25 and 34 and each of the claims depending therefrom as well as claims 3-8, 10-12 and 14-22 and 24 are allowable over the cited art. Notification of such allowability is thus respectfully requested.

Applicant submits herewith a one month Petition for Extension of Time in which to respond to the Office Action along with a check in the amount of \$120.00 to cover the extension of time fees. The Commissioner is hereby authorized to charge any deficiencies and/or credit any overpayments to Deposit Account No. 04-1420.

Conclusion

This application now stands in allowable form, and reconsideration and allowance are respectfully requested.

Respectfully submitted,

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